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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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| 09/311,837 | 05/14/99 | BARTA | T MON-116.6 |

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EXAMINER

CHANG, C

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1625

DATE MAILED:

05/08/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/311,837

Applicant
Barta et al.

Examiner
Celia Chang

Group Art Unit
1625



☒ Responsive to communication(s) filed on Mar 13, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 (one) month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-146 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-146 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Art Unit: 1625

DETAILED ACTION

1. Claims 1-146 are in the case.

2. *Restriction*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 86, 95-104, drawn to piperidiny1 compounds, classified in class 546, subclass 225+. If this group is elected, generic claims 52-85, 87-92 reading on the elected compounds (wherein one of X, Y, Z is N, other are C; $m+n+p=3$). The pharmaceutical composition claims 128-131 and the method claims 7-33, 35-40 upon election of a single pathology to be treatable by the elected compound can be prosecuted with the compounds to the extend of the election. Process of making the compounds, claims 34, 43-51, can be prosecuted with the elected compounds to the extend of making the same election.
- II. Claims 93-94, drawn to pyranyl compounds, classified in class 549, subclass 356+. If this group is elected, generic claims 52-85, 87-92 reading on the elected compounds (wherein one of X, Y, Z is O, other are C; $m+n+p=3$). The pharmaceutical composition claims 128-131 and the method claims 7-33, 35-40 upon election of a single pathology to be treatable by the elected compound can be prosecuted with the compounds to the extend of the election. Process of making the compounds, claims 41-42, can be prosecuted with the elected compounds to the extend of making the same election.

Art Unit: 1625

- III. Claims 52-85, 87-92, when one of X, Y, Z is S $m+n+p=3$, drawn to thiopyranyl compounds, classified in class 549, subclass 13+. If this group is elected, a further election of a single disclose species of compound is also required. The pharmaceutical composition claims 128-131 and the method claims 7-33, 35-40 upon election of a single pathology to be treatable by the elected compound can be prosecuted with the compounds to the extend of the election. Process of making the compounds, claims 41-42, can be prosecuted with the elected compounds to the extend of making the same election.
- IV. Claims 52-85, 87-92, when $m+n+p=1$, drawn to four member ring heterocyclic compounds, classified in class 540, subclass various. If this group is elected, a further election of a single disclose species of compound is also required. The pharmaceutical composition claims 128-131 and the method claims 7-33, 35-40 upon election of a single pathology to be treatable by the elected compound can be prosecuted with the compounds to the extend of the election. Process of making the compounds, claims 34-51, can be prosecuted with the elected compounds to the extend of making the same election.
- V. Claims 52-85, 87-92, when $m+n+p=2$, drawn to five member ring heterocyclic compounds, classified in class 548, subclass various. If this group is elected, a further election of a single disclose species of compound is also required. The pharmaceutical composition claims 128-131 and the method claims 7-33, 35-40 upon election of a single pathology to be treatable by the elected compound can be prosecuted with the compounds to the extend of the election. Process of making the compounds, claims 34-51, can be prosecuted with the elected compounds to the extend of making the same election.

Art Unit: 1625

- VI. Claims 52-85, 87-92, when $m+n+p=4$, drawn to seven member ring heterocyclic compounds, classified in class 540, subclass various. If this group is elected, a further election of a single disclosed species of compound is also required. The pharmaceutical composition claims 128-131 and the method claims 7-33, 35-40 upon election of a single pathology to be treatable by the elected compound can be prosecuted with the compounds to the extend of the election. Process of making the compounds, claims 34-51, can be prosecuted with the elected compounds to the extend of making the same election.
- VII. Claims 1-6, drawn to method of treating MMP related diseases employing compounds which are not encompassed by groups I-VI, classified in class various, subclass various, depending on species election. If this group is elected, a further election of a single disclosed species is also required.
- VIII. Claims 105-127 and 132-144 being drawn to intermediates and process of making thereof, classified in class various, subclass various, depending on species election. If this group is elected, a further election of a single disclosed species is also required and further restriction may be required.

The inventions are distinct, each from the other because:

Inventions of groups I-VIII are independent and patentably distinct products or intermediates. Each group of compounds differ in element, bonding arrangement and chemical properties to such an extend that a reference anticipating compounds of one group would not render compounds of another group obvious. Unpatentability of any one group of invention would not necessarily imply unpatentability of another group of invention.

Art Unit: 1625

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Should applicant traverse on the ground that the inventions or the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention. In the instant case then there would have been no patentability of all the claims since Venkatesan et al. WO 98/37877 disclosed compounds anticipating the claims, (see R2-R3 forms heterocyclic rings, only abstract is provided for now) and has an earlier US filing date in national stage prosecution.

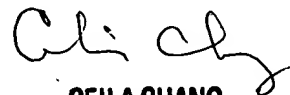
Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celia Chang whose telephone number is (703) 308-4702.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

CCC/Chang

May 4, 2000


CEILA CHANG
PRIMARY EXAMINER
GROUP 1200-1625